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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/636,039

Filing Date: August 09, 2000

Appellant(s): GRAHAM ET AL.

Jeffrey S. King
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 5, 2009 appealing from the Office action mailed December 9, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Adobe Systems Incorporated, Acrobat Reader screenshots, 1999, Adobe Systems Incorporated, Version 4.0

5,546,502	HART ET AL.	8-1999
6,326,957	NATHAN ET AL.	12-2001
6,339,437	NIELSEN	1-2002
2002/0065814	OKAMOTO ET AL.	5-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 11-19, 30-38, and 40-44 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for annotating previously defined keywords/phrases, does not reasonably provide enablement for "...each annotation visually emphasizes the one or more keywords and related text surrounding the locations of the one or more keywords." The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The specification only teaches that annotations are created based on the stored keywords/phrases, while never disclosing any teachings or understanding of the idea of emphasizing related text

(not including stored keywords) surrounding the locations of the keywords. In order to expedite prosecution the examiner will interpret the claims as though the amendment was properly enabled. However, this does not remove the requirement for proper correction by the applicant in the form of either (a) pointing out specifically where this limitation is taught in the specification or (b) properly amending the claims to remove any deficiently enabled limitations.

Claims 11-14, 17 18, 30-33, 36, 37, and 40 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) in view of Hart et al. (hereinafter Hart, US Patent Number 5,546,502, issued August 13, 1999) further in view of Nathan et al. (hereinafter Nathan, US Patent Number 6,326,957, filed January 29, 1999).

In regard to independent claim 11, Acrobat discloses a method in which a document is accessed and a section of that document is shown in a first area and thumbnails of the document are displayed in a second area (Page 1-3 of Acrobat). Acrobat also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat). Acrobat also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) and changed dynamically as the portion that is viewed is changed to a different portion (Page 1-4, items 1-4 of Acrobat, the box in the thumbnail changes based on the portion being

viewed). Acrobat discloses a method in which determining information about a document (coordinates and dimension) includes determining information about text, forms, graphics, images, and links (Pages 1-5 of Acrobat).

Acrobat does not disclose a method in which the user selects from plurality of concepts rather than entering a query, the concepts having keywords associated with them. However, Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns (one keyword and other related text – additional keywords) associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Acrobat with the query-free teachings of Hart because it would have provided relevant documentation for the current context more efficiently without the user having to formulate a query and wait for results (column 6, lines 31-44 of Hart).

Acrobat also does not disclose dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document. However, Nathan teaches dynamically maintaining thumbnail images to keep them concurrent with the document they represent by dynamically updating the content of the image to any change, which would include annotations (column 6, lines 14-18 of Nathan et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Acrobat with the teachings of Nathan because

it would have allowed the thumbnail image to correctly represent the most current state of the document regardless of any changes made.

In regard to dependent claim 12, Acrobat discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat).

In regard to dependent claim 13, Acrobat discloses a method in which the thumbnail sizes can be changed to a different reduction level (reduction ratio) and the content still correctly corresponds to the original document (Page 1 and 5, items 1 and 5 of Acrobat).

In regard to dependent claim 14, Acrobat does not disclose a method in which the selects from plurality of concepts rather than entering a query, the concepts having keywords associated with them. However, Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Acrobat with the query-free teachings of Hart because it would have provided relevant documentation for the current context more efficiently without the user having to formulate a query and wait for results (column 6, lines 31-44 of Hart).

In regard to dependent claim 17, Acrobat discloses a method in which determining information about a document (coordinates and dimension) for creating thumbnail representations of the document incorporate all formatting of that document (Pages 1-5 of Acrobat).

In regard to dependent claim 18, Acrobat discloses a method in which determining information about a document (coordinates and dimension) includes determining information about text, forms, graphics, images, and links (Pages 1-5 of Acrobat).

In regard to independent claim 30 and dependent claims 31-33 and 36-37, the claims incorporate substantially similar subject matter as claims 11-14 and 17-18. Thus, the claims are rejected along the same rationale as claims 11-14 and 17-18.

In regard to independent claim 40, the claim incorporates substantially similar subject matter as claim 11. Thus, the claim is rejected along the same rationale as claim 11.

Claims 15, 19, 34, 38, and 41-43 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) further in view of Hart et al. (hereinafter Hart, US Patent Number 5,546,502, issued August 13, 1999) and further in view of Nathan et al. (hereinafter Nathan, US Patent Number 6,326,957, filed January 29, 1999, cited by the examiner in PTO-892 mailed on 12/15/2006).

In regard to dependent claim 42, Acrobat does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality (first and second) of concepts. However, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed (column 1, line 17-column 2, line 16 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Nielsen because it would have provided a user with a simple way to search and identify terms when viewing a document.

In regard to dependent claim 15, Acrobat discloses a method in which the thumbnail representations of the document incorporate all formatting of that document which would include highlighted text entities (Pages 1-5 of Acrobat).

In regard to independent claim 19, Acrobat discloses a method in which a document is accessed and a section of that document is shown in a first area and thumbnails of the document are displayed in a second area (Page 1-3 of Acrobat). Acrobat also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to

correctly place the information in the thumbnail representation (Page 1-3 of Acrobat). Acrobat also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) and changed dynamically as the portion that is viewed is changed to a different portion (Page 1-4, items 1-4 of Acrobat, the box in the thumbnail changes based on the portion being viewed).

Acrobat does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality of concepts. However, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed, in a manner that is independent of a second query being made (column 1, line 17-column 2, line 16 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Nielsen because it would have provided a user with a simple way to search and identify terms when viewing a document.

Neither Acrobat nor Nielsen disclose a method in which the selects from plurality of concepts rather than entering a query, the concepts having keywords associated with them. However, Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns (one keyword and other related text – additional keywords) associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Acrobat and Nielsen with the query-free teachings of Hart because it would have provided relevant documentation for the current context more efficiently without the user having to formulate a query and wait for results (column 6, lines 31-44 of Hart).

Acrobat also does not disclose dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document. However, Nathan teaches dynamically maintaining thumbnail images to keep them concurrent with the document they represent by dynamically updating the content of the image to any change, which would include annotations (column 6, lines 14-18 of Nathan et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Acrobat with the teachings of Nathan because it would have allowed the thumbnail image to correctly represent the most current state of the document regardless of any changes made.

In regard to dependent claims 34 and 43, the claims incorporate substantially similar subject matter as claims 15 and 42. Thus, the claims are rejected along the same rationale as claims 15 and 42.

In regard to independent claims 38 and 41, the claims incorporate substantially similar subject matter as claim 19. Thus, the claims are rejected along the same rationale as claim 19.

Claims 16 and 35 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) further in view of Hart et al. (hereinafter Hart, US Patent Number 5,546,502, issued August 13, 1999), further in view of Nathan et al. (hereinafter Nathan, US Patent Number 6,326,957, filed January 29, 1999, cited by the examiner in PTO-892 mailed on 12/15/2006), and further in view of Okamoto et al. (hereinafter Okamoto, US Patent Application Publication Number 2002/0065814, US Filing date June 30, 1999).

In regard to dependent claim 16, none of Acrobat, Nielsen, Hart, or Nathan disclose a method in which the style information relevant to a concept is modified and in response all entities that correspond to that concept are changed to correspond with the new style information. However, Okamoto discloses a method in which a concept tag number, which corresponds to one of a plurality of concepts, is directly associated with a specific style (page 12, paragraph 0270-0276 of Okamoto). When that style information is changed all tags corresponding to the tag number associated with that

style information will reflect that change (page 12, paragraph 0270-0276 of Okamoto). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Okamoto because it would have provided a user with a simple way to search and customize the identification of terms when viewing a document.

In regard to dependent claim 35, the claim incorporates substantially similar subject matter as claim 16. Thus, the claim is rejected along the same rationale as claim 16.

(10) Response to Argument

Regarding the appellant's arguments on page 10, in reference to the rejection of claims 11-19, 30-38, and 40-44 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for annotating previously define keywords/phrases, does not reasonably provide enablement for "...each annotation visually emphasizes the one or more keywords and related text surrounding the locations of the one or more keywords," the examiner respectfully disagrees and maintains that the rejection is proper. The appellant has pointed to a specific section of the specification as provided support and enablement for the limitation (page 6, lines 18-25 of appellant's specification). For the most part this section only discusses the different types of annotations that can be used to visually emphasize specifically the keywords only. The only statement in this section that does not specifically deal with only the keywords in

the portions that states, "...a marginal annotation in the form of a rectangular bar may indicate a paragraph that has been determined to have relevance above a predetermined threshold or to have more than a threshold number of key phrases." This also does not provide enablement for the limitation. Merely placing a bar in the margin as defined by this statement does not support the limitation of visually emphasizing "related text" surrounding the keywords. The margin can by no means be defined as being "related text" and by placing a bar in the margin the actual "related text" itself has not been visually emphasized in any way, visually the "related text" has been completely unaffected. Thus, the examiner maintains that the rejection is proper, however regardless of this fact the examiner has continued to provide an art rejection for this limitation in the previous rejections as though it was actually enabled.

Regarding the appellant's arguments on pages 11-13, in reference to the rejection of claims 11-14, 17, 18, 30-33, 36, 37, and 40 as being obvious, specifically dealing with the limitation that states, "...dynamically changing the contents of a single thumbnail to reflect a change in the contents of the document displayed in the first viewing area," the examiner respectfully disagrees and maintains that the rejection is proper. Nathan teaches dynamically maintaining thumbnail images to keep them concurrent with the document (digital page) that they represent by dynamically updating the content of the image (column 6, lines 14-18 of Nathan). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Acrobat with the teachings of Nathan because it would have allowed the thumbnail image to correctly represent the most current state of the document

regardless of any changes made. The combination of the teachings of Acrobat with the teachings of Nathan properly rejects the limitation as described above. Nathan teaches that a thumbnail image representing a document should be dynamically updated and Acrobat teaches that a document viewing area would contain a document in one viewing area and a thumbnail representation of the document in a second viewing area, which then based on the teachings of Nathan could obviously be dynamically updated. Thus, one of ordinary skill in the art would have seen it obvious to have dynamically updated the thumbnail in the second viewing area of Acrobat based on the teachings in Nathan. The appellant has provided no arguments to the combination of the reference, rather merely arguing the Nathan reference alone, and in response to arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Thus, the rejection is proper and will be maintained.

Regarding the appellant's arguments on pages 13 and 14, in reference to the rejection of claims 15, 19, 34, 38, and 41-43 as being obvious, specifically dealing with the limitation that states, "...each annotation visually emphasizes the one or more keywords and related text surrounding the locations of the one or more keywords," the examiner respectfully disagrees and maintains that the rejection is proper. It appears that the appellant is arguing that Nielson does not teach this limitation and thus the rejection is improper. However, it is important to note that the examiner relied upon the

Hart reference to teach this limitation in the rejection presented in the previous action.

Hart teaches a system that searches for a concept (one or more keyword) and in the process of searching for the concept it emphasizes both the concept and other text patterns (related text) related to the concept that are also throughout (surrounding the keywords) the document containing the concept (column 3, line 39-column 4, line 61 of Hart). The appellant has provided no argument for the rejection of the limitation in view of the Hart reference, thus the examiner maintains that the rejection is proper.

Regarding the appellant's arguments on pages 14 and 15, in reference to the rejection of claims 16 and 35 as being obvious, specifically dealing with the limitation that states, "...modifying the style information for the first concept thereby changing the appearance of the document displayed in the first viewing area," the examiner respectfully disagrees and maintains that the rejection is proper. Okamoto discloses a method in which a concept tag number, which corresponds to one of a plurality of concepts, is directly associated with a specific style (page 12, paragraph 0270-0276 of Okamoto). When that style information is changed all tags corresponding to the tag number associated with that style information will reflect that change (page 12, paragraph 0270-0276 of Okamoto). Thus, Okamoto teaches that each concept is explicitly associated with a concept number, the concept number being associated with a specific style. The reason for this type of setup is so the code necessary to apply the style doesn't have to be physically imposed on each portion of the document that requires the style; rather it would be added by reference to the concept tags. Thus, if the style referenced by the concept tag is changed in any way for any reason it will be

reflected throughout the display of the document wherever that concept tag has been placed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Okamoto because it would have provided a user with a simple way to search and customize the identification of terms when viewing a document. Thus the examiner maintains that the rejection is proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Joshua D Campbell/

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/Stephen S. Hong/

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